

# Kluwer Trademark Blog

## CIPO Implements Initiatives to Cut Down on Delays in Examination

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The Canadian Intellectual Property Office (“CIPO”) published two new practice notices on Monday, May 3<sup>rd</sup>, 2021, dealing with expedited examination and improving timeliness in examination. The prospect of expedited and more timely examination will be welcomed by trademark owners, frustrated with extended delays in examination.

### **Expedited Examination**

Beyond very limited opportunities for marks covering goods and services related to the COVID-19 pandemic, expedited examination has not been available in recent years. There are now additional opportunities for expedited examination where one or more of the following criteria are met:

- A court action is expected or underway in Canada with respect to the applicant’s trademark in association with the goods or services listed in the application;
- The applicant is in the process of combating counterfeit products at the Canadian border with respect to the applicant’s trademark in association with the goods or services listed in the application;
- The applicant requires registration of its trademark in order to protect its intellectual property rights from being severely disadvantaged on online marketplaces; or
- The applicant requires registration of its trademark in order to preserve its claim to priority within a defined deadline and following a request by a foreign intellectual property office.

Requests must be in the form of an affidavit or a statutory declaration, and there is no government fee associated with such a request.

### **Improving Timeliness in Examination**

CIPO is also committed to reducing delays in examination. In addition to hiring more examiners, CIPO has implemented the following practices during examination of trademark applications:

- Generally, examiners will no longer provide examples of acceptable goods or services in the first examiner’s report, unless the goods/services issue can be resolved through a “telephone amendment” (which would only be for cases involving very minor amendments to goods/services).

- Applications, both new and amended, filed with the Trademarks Office covering only goods or services selected from a pre-approved list (specifically, goods and services listed as approved in CIPO's *Goods and Services Manual*) will be examined more quickly and, in some cases, prior to those applications that did not use the pre-approved list. This represents a big departure from CIPO's traditional practice of examining applications in the order in which they are filed.
- Examiners will reduce the number of reports issued and the Office will, where reasonable, refuse trademarks in a more timely manner. In that regard, examiners will only be required to entertain a particular submission or argument once. As such, the applicant should make every effort to avoid making piecemeal arguments. In other words, if state of the Register evidence is advanced to overcome an objection, it should all be raised in the first response, as opposed to raising additional state of the Register evidence in response to a second examiner's report. Such additional evidence will not result in issuance of a further examiner's report, although it will be considered in the Registrar's decision to either withdraw the objection or refuse the trademark.

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